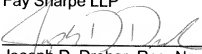
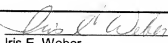


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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket No.: LUTZ 200250US01 Benco 39 | |
| Application No.: 10/698,783 | | Filed: October 31, 2003 | |
| Title: A METHOD AND APPARATUS FOR PROVIDING MOBILE-TO-MOBILE VIDEO CAPABILITY TO A NETWORK | | | |
| First Named Inventor: Benco | | | |
| Art Unit: 1742 | | Examiner: Dean, Raymond S. | |
| <p>Applicant(s) request(s) review of the final rejection in the above-identified application.</p> <p>No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).</p> <p style="padding-left: 40px;"><i>Note: No more than five (5) pages may be provided.</i></p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest See 37 CFR 3.71.</p> <p>Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record.</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.</p> <div style="text-align: right; margin-top: 20px;"> <p>Respectfully submitted,</p> <p>Fay Sharpe LLP</p>  <p>Joseph D. Dreher, Reg. No. 37,123 The Halle Building, 5th Floor 1228 Euclid Avenue Cleveland, OH 44115-1843 216.363.9000</p> </div> <p>Date: March 14, 2011</p> <p>NOTE: Signature(s) of all the inventor(s) or assignee(s) of record of the entire interest or their representative(s) is/are required. Submit multiple forms if more than one signature is required, see below*.</p> | | | |
| <p><input type="checkbox"/> *Total of forms are submitted.</p> | | | |
| Certificate of Transmission or Mailing | | | |
| I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being transmitted to the USPTO by electronic transmission via EFS-Web on the date indicated below. | | | |
| March 14, 2011 | |  Iris E. Weber | |
| Date | | | |

Status of Application

Independent claims 1, 10 and 18 are pending in the subject application. Dependent claims 2-5, 7-9, 11-17 and 19-23 are also pending. A Final Office Action dated October 12, 2010 rejected independent claims 1 and 10 (and dependent claims 2, 4-5, 7, 11-15 and 19) under 35 U.S.C. § 103(a), contending that the claims are unpatentable over U.S. Pub. No. 2004/0180689 to Nayak in view of U.S. Pub. No. 2002/0132608 to Shinohara, in view of U.S. Pub. No. 2003/0045273 to Pyhalammi, *et al.* and in further view of U.S. Pub. No. 2004/0103434 to Ellis. Claims 18 (and dependent claims 20 and 23) were rejected under 35 USC § 103(a) as being unpatentable over Nayak in view of Shinohara and Pyhalammi and in further view of U.S. Patent Publication No. 2003/0105825 to Kring, *et al.* The remaining dependent claims were rejected as being obvious in view of Nayak, Shinohara, Pyhalammi, and other references.

Applicants filed a response to the Final Office Action on December 13, 2010, and received an Advisory Action on December 23, 2010. The Advisory Action indicated that the Examiner has maintained his rejection of the claims.

Clear Errors and/or Omissions of the Office Action

Claim 1

Generally, the subject application relates to mobile-to-mobile video capability on a network. A delivery preference for a user of a mobile station can be determined.

The rejection of claim 1 based on a combination of Nayak with Shinohara, Pyhalammi and Ellis is **clear error** for at least the following reason. A combination of Nayak with Shinohara, Pyhalammi and Ellis fails to render independent claim 1 obvious.

The Examiner relies on Nayak to disclose a mobile switching center comprising a call recognition module operative to recognize a call from the first mobile station to the second mobile station as including the video data and, if the video data is present, validate the second mobile station as capable of receiving the video data.

The Examiner concedes that the cited portion of Nayak fails to disclose a determining a delivery preference for the second mobile station based at least in part on

information retrieved from at least one database, wherein a subscriber sets the delivery preference by selecting immediate delivery, delayed delivery, blocked delivery, or conditional delivery, as claimed. The Examiner also concedes that Nayak does not disclose the claimed storage module, the claimed announcement module, or the claimed control module. (See Final Office Action dated October 12, 2010; pages 3-4).

The mobile switching center of Nayak may disclose determining whether a called party can accept a video call. However, determining whether a party can accept a video call differs from determining a delivery preference. The Examiner has not established how the mobile switching center in Nayak could be modified to include determining a delivery preference for a second mobile station. Furthermore, applicants assert that it is not obvious to modify Nayak to disclose determining a delivery preference for a second mobile station.

Also, independent claim 1 recites that the mobile switching center comprises an announcement module to selectively prompt, based on the delivery preference, the second mobile station if the second mobile station is validated, receive a response to the prompt from the second mobile station and selectively forward the response. It is unclear how the mobile switching center of Nayak could be modified to include the claimed announcement module.

It is also submitted that a person having ordinary skill in the art would not combine the cited references to render the claims obvious.

Nayak relates to a system that addresses a problem with mobile phones having different functionality. Nayak states that when phones of different generations do not have the same functionality (e.g., when one mobile phone has video capability but another mobile phone does not have video capability) but still try to communicate, calls are typically lost.

In Nayak, a technique is disclosed whereby the system first determines whether two mobile phones seeking to communicate have the same functionality (e.g., video capability). If not, the system of Nayak does not drop the call but instead establishes a communication session in which both phones can participate (e.g., a voice call). The video data is sent elsewhere in this case.

It is submitted that the Examiner is relying on hindsight bias to disclose the claimed subject matter. Accordingly, since the focus of Nayak is on addressing the problem of incompatible phones, where one phone is unable to receive video, one of skill in the art would not look to any of Shinohara, Pyhalammi or Ellis (let alone all of them) to modify Nayak to add functionality on allowing for user preferences for delivery when phones are compatible. Nayak seeks to solve a network problem, not provide more choices to users. Thus, it is submitted that the suggested combination of Nayak, Shinohara, Pyhalammi and Ellis would not be made and would not render the claims obvious.

Further, even if some of the suggested functionality could somehow be combined, the resultant system would not necessarily have all functionality within a mobile switching center, as claimed. The Examiner has not fairly established how this could be accomplished.

Accordingly, it is respectfully requested that the rejection of independent claim 1 (and associated dependent claims 2-5 and 7-9) is **clear error**.

Claim 10

With respect to independent claim 10, the Examiner concedes that Nayak does not disclose determining a delivery preference for the second mobile station based at least in part on information retrieved from at least one database. The Examiner also concedes that Nayak does not disclose storing the video data in a storage module, selectively prompting, based on the delivery preference, the second mobile station if the second mobile station is validated; receiving a response to the prompt from the second mobile station; and performing maintaining, deleting or forwarding to the second mobile station.

The Examiner has relied on the same reasons for the rejection of independent claim 10 as independent claim 1. Thus, it is submitted that the arguments with respect to independent claim 1 also apply to independent claim 10. Accordingly, the rejection of independent claim 10 (and associated dependent claims 11-17) is **clear error**.

Claim 18

The rejection of claim 18 based on a combination of Nayak with Shinohara, Pyhalammi, Ellis and Kring is **clear error** for at least the following reason. A combination of Nayak with Shinohara, Pyhalammi, Ellis and Kring fails to render independent claim 18 obvious.

Independent claim 18 recites a mobile switching center comprising means for validating the second mobile station as capable of receiving the video data and determining a delivery preference for the second mobile station based at least in part on information retrieved from at least one database, wherein delivery preferences include a rejection of video data, immediate delivery of video data, delayed delivery of video data and conditional delivery of video data. Independent claim 18 also recites a mobile switching center comprising means for storing, means for selectively prompting, means for receiving, and, means for performing.

Kring appears to disclose a mobile switching center (MSC), but similarly to Nayak, Kring does not disclose or suggest that the MSC can be modified to incorporate the equivalent functions of the claimed modules. It is submitted that a person having ordinary skill in the art would not combine the cited references and produce an operative device. Thus, similar to above, it is submitted that the combination of Nayak, Shinohara, Pyhalammi and Kring is not obvious.

Further, even if some of the suggested functionality could somehow be combined, the resultant system would not necessarily have all functionality within a mobile switching center, as claimed. The Examiner has not fairly established how this could be accomplished. Thus, it is submitted that the rejection of independent claim 18 (and associated dependent claims 19-23) is **clear error**.

Conclusion

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (claims 1-5 and 7-23) are now in condition for allowance.